

**REMARKS**

Applicants thank Examiner Hsu for the courtesy and consideration extended to Applicants' representative during the telephonic interview of November 18, 2004. During the interview, the rejections contained in the Office Action mailed on August 3, 2004, were discussed. In that Office Action, claims 1-68 were rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the enablement requirement; claims 21-34 were rejected as being "vague and indefinite"; claims 1-20 and 35-77 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite; and claims 69-77 were indicated as allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112, ¶ 2.

By this Amendment, Applicants have amended the specification to update the information for the parent application, have amended claims 1, 9, 35, 43, 55, and 69 to correct minor informalities, and have added new claims 78-84.

**Rejection Under 35 U.S.C. § 112, ¶ 1**

In the Office Action, claims 1-68 were rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

A specification is enabling if one skilled in the art could make and use the claimed invention without undue experimentation. *See* MPEP § 2164.04. As the Examiner is aware, the burden is on the Examiner to establish that the specification is not enabling. *Id.*

The Office Action asserts that the specification is not enabling because "[t]here is no physical implementation being disclosed for forming the claimed apparatus comprising the claimed elements or performing the claimed steps." (Office Action at 2.) Applicants respectfully disagree because Applicants' specification does show a physical implementation. For example, Figure 2 shows a block diagram of a hardware environment. The accompanying

text in the specification explains that the components shown in Figure 2 (e.g., network management card 30) may be used to implement the claimed invention. (*See, e.g.*, page 10.) Based on this disclosure and the other disclosure in this application, Applicants submit that one skilled in the art could make and use the claimed invention without undue experimentation.

Indeed, during the interview, the Examiner agreed with Applicants' representative that Applicants' specification is enabling. Thus, Applicants respectfully request that the rejection under 35 U.S.C. § 112, ¶ 1, be withdrawn.

#### **"Single Means" Rejection**

In the Office Action, claims 21-34 were rejected as being "vague and indefinite since each claim recites only a single means (i.e., 'an intelligent port-distribution mechanism') and thus encompasses all possible means for performing a desired function." (Office Action at 2.) Applicants respectfully traverse this rejection as well.

During the telephonic interview, the Examiner explained this rejection, stating that claim 21 is a "single means" claim because it recites only one limitation, i.e., "an intelligent port-distribution mechanism that moves ports to new segments to accomplish load-balancing," and that this limitation is a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6. Applicants respectfully disagree because the "intelligent port-distribution mechanism" limitation is not a means-plus-function limitation.

As the Examiner is aware, "a claim element that does not include the phrase 'means for' or 'step for' will not be considered to invoke 35 U.S.C. § 112, sixth paragraph." MPEP § 2181. The "intelligent port-distribution mechanism" limitation does not include the phrase "means for" as required by § 2181. At least for this reason, the "intelligent port-distribution mechanism" limitation is not a means-plus-function limitation and claim 21 is not a "single means" claim.

Indeed, during the interview, the Examiner agreed that claim 21 is not a “single means” claim and agreed to withdraw the rejection of claims 21-34 as being “vague and indefinite.”

**Rejection Under 35 U.S.C. § 112, ¶ 2**

In the Office Action, claims 1-20 and 35-77 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Although Applicants disagree with this rejection, to expedite prosecution of this application, Applicants have amended claims 1, 9, 35, 43, 55, and 69 in accordance with the discussion between Applicants’ representative and the Examiner. Applicants note, as did the Examiner during the interview, that the changes to these claims do not alter the scope of these claims. (*See Interview Summary Form.*) In sum, Applicants respectfully request that the rejection of these claims and of claims 2-8, 10-20, 36-42, 44-54, and 56-68, and 70-77 that depend from these claims be withdrawn.

**Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 2, 2004

By:   
Naveen Modi  
Reg. No. 46,224